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| 09/843,000 | 04/26/2001 | Frank Charles Pagano | Rev 98-25 | 7885 |
| 26807 7590 11/25/2008 JULIE BLACKBURN REVLON CONSUMER PRODUCTS CORPORATION 237 PARK AVENUE NEW YORK, NY 10017 | | | | |
| EXAMINER | | | | |
| PURDY, KYLE A | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/843,000

Applicant(s)

PAGANO ET AL.

Examiner

Kyle Purdy

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/17/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61, 64, 66, 68 and 82-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61, 64, 66, 68 and 82-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Application

1. The Examiner acknowledges receipt of the arguments filed on 10/17/2008.

2. Claims 61, 64, 66, 68 and 82-88 are presented for examination on the merits. The following rejections are made.

Response to Applicants' Arguments

3. Applicants arguments filed 10/17/2008 regarding the rejection of claims 61, 64, 66, 68 and 82-88 made by the Examiner under 35 USC 103(a) over Stella (US 3928656) in view of Ohno (US 5854365) and Perronin et al. (US 3991007), evidenced by US5798426 have been fully considered but they are not found persuasive.

4. Applicants arguments filed 10/17/2008 regarding the rejection of claims 61, 64, 66, 68 and 82-88 made by the examiner under 35 USC 103(a) is **MAINTAINED** for the reasons of record in the office action mailed on 08/19/2008.

5. In regards to the 103(a) rejection, Applicant asserts the following:

A) The current application is directed to a formulation that is used in treating humans whereas the cited references are all directed to formulations for use in printer technologies, thus they are not analogous to the instant application;

B) The Examiner ignores the teaching of Stella that there is a necessity of a specific glass transition temperature and that the corresponding polymers are affixed by electrostatic interaction and are therefore not suitable for application to human nails; and

C) The Examiner fails to provide an apparent reason why the addition of arbitrary pigment to the teaching of Stella from Ohno would be obvious to one of ordinary skill in the art.

6. With respect to assertion A, the Examiner respectfully disagrees. The fact that the composition claimed by Applicant is to be applicable to human nails is immaterial to the structure of the composition because such a recitation is an intended use and is not given any patentable weight. See MPEP 2106.II C. Moreover, it is the position of the Examiner the composition disclosed by the references would be suitable for application to the human nails, despite being associated with printer and toner technologies since it is not toxic.

7. With respect to assertion B, this argument is perplexing. First of all, Applicant is claiming a composition which comprises a copolymer of acrylic acid and butyl methacrylate such that the copolymer contains about 2-14% wt. acrylic acid and the copolymer has a glass transition temperature in the range of 5 to 90 degrees Celsius. Strella teaches a toner composition which comprises an ionic n-butyl methacrylate-acrylic acid copolymer (94.2/5.8) with a TG of 46 degrees Celsius. The copolymer of Strella reads on the instant claim, and it would necessarily have the instant properties which Applicant is currently stating it doesn't i.e. ability to affix to the surface of a nail. Applicant is directed to the teaching of Block (J. Bio. Chem., 1934, 104, 339-341). Block states that finger nails, when subject to acid hydrolysis, yield quantities of histidine, lysine and arginine such that the molecular ratios are respectively 1:4:12. As all of these amino acids bear a positive ionic charge, there is no reason to believe that the anionic copolymer of Strella would not electrostatically interact with the amino acids and affix the composition to the surface of the nail. Applicants arguments are not found persuasive.

8. With respect to assertion C, the motivation for one of ordinary skill comes from the teaching of Strella. Strella states that their compositions may comprise pigments or dyes such as carbon black, commercial red, yellow, blue or any other well-known pigment. See column 6,

lines 4-16. Thus, by such a teaching, one of ordinary skill in the art would look to other teachings for pigments and dyes suitable for use in formulations in order to provide a color functionality.

Maintained Rejections
Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 61, 64, 66, 68 and 81-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strella et al (3,928,656; of record) in view of Ohno (5854365; of record) in view of Perronin et al (3,991,007; of record) as evidenced by US 5,798,426 (of record).

11. Strella discloses a method of developing electrostatic latent images with pressure sensitive toner. The toner comprises 19 parts of an ionic polymer (15.8%), 100 parts of tetrahydrofuran (ether solvent-83.3%), and 1 part Mogul black (pigment- 0.8%) (see example 1 and preparation of toner, column 9; see instant claim 61, 64 and 66). The ionic polymer disclosed is butyl methacrylate-acrylic copolymer (94.2/5.8) with a TG of 46 degrees Celsius (see examples II and VIII; see instant claim 61). Strella teaches the use of a pigment or dye such as carbon black, a commercial red, blue, or yellow dye, or any other well-known pigment in an amount of 1-20% (see column 6, lines 4-16; see instant claim 87).

12. Although Strella teaches pigments in the composition, the instant pigments are not specified. Further, the instant solvents and the inclusion of nitrocellulose are not taught.

13. Ohno teaches a toner composition wherein the pigment may be carbon black, an aniline black, acetylene black, naphthol yellow, Hansa yellow, rhodamine lake, alizarin lake, iron oxide red, phthalocyanine blue and indanthrene blue in the amount of 0.1-20% (see column 22, lines 25-40; see instant claim 61 and 87).

14. Perronin teaches the preparation of pigmentary particles coated with an organic polymer to allow dispersion of the pigment in a medium. Perronin discusses the importance of pigments in many fields such as textiles, plastics, inks, dyes, and cosmetics (see column 1, lines 10-12). Perronin teaches the pigment compositions may be advantageously used in numerous fields of application, such as inks, plastics materials, paints, or other colored preparations (see column 4, lines 45-55). Perronin teaches examples of monomers which may be used in the process include 1) alkene-mono- or di-carboxylic acids, preferably the acids containing up to five carbon atoms, for example acrylic, methacrylic, etc.; 2) esters of these acids, such as methyl, ethyl, butyl, etc. (see column 3, lines 40-60; see instant claim 61). Perronin teaches the pigments used in the composition may be iron oxides and titanium dioxide (see column 2, line 65 to column 3, line 5; see instant claim 61). The solvents may be selected from gasolines, aromatic hydrocarbons such as benzene, toluene, xylene, halogenated hydrocarbons such as trichloroethylene, perchloroethylene, chlorobenzene, trichlorobenzene, chlorofluoromethanes, chlorofluoroethanes, alcohols such as methanol, ethanol, n-propanol, 1-methyl-ethanol, n-butanol, 2-methyl-propanol, 1,1-dimethyl-ethanol, ketones such as 2-propanone, 2-butanone, 4-methyl-2-pentanone, esters such as ethyl acetate, propyl acetate, 1-methyl-ethyl acetate, ethers such as diethyl ether, ethylpropyl ether, tetrahydrofuran, and 1,4-dioxan (see column 2, lines 45-61; see instant claim 61).

15. Example 6 provides a composition (composition D) with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. 190 parts of composition D is then combined with 86 parts of 50% nitrocellulose resin in butyl acetate, 210 parts ethyl acetate (ester solvent), 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer). Note that in composition of Example 6, nitrocellulose comprises about 1.0 % by weight of the total composition (math not shown; see instant claims 81 and 82). It is taught that nitrocellulose enhances the coloristic development of the pigmented ink (see column 7, line 55).

16. US 5,798,426 discloses BMA/AA (90/10) has a weight of 69,400 (see instant claims 83 and 84).

17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Strella, Ohno, and Perronin and substitute tetrahydrofuran with the claimed solvents such as isopropanol, ethyl acetate and so on. One would have been motivated to do so since Perronin teaches tetrahydrofuran and the claimed solvents are utilized as the organic solvents for the copolymers. Regarding the inclusion of the instantly claimed pigments, because they are obvious. Ohno and Perronin both teach pigments for use in compositions comprising polymers. With regard to claims 81 and 82, Perronin teaches including about 1.0% of nitrocellulose in their composition which obviates the instantly claimed ranges. One would have been motivated to include nitrocellulose into the pigmented composition in order to enhance the coloristic development of the final formulation. With regard to the functional limitations (i.e. a nail enamel) of the instant claims, it is the position of the Examiner that Strellas and Perronin's composition is capable of leaving a water-insoluble film on the nail since the compositions are substantially similar. With regard to the copolymers molecular

weight, the Examiner cites US 5,798,426 as art of interest wherein '426 states that BMA/AA (90/10) has a weight of 69,400, which reads on about 68,000. Therefore, a composition comprising a solvent, a pigment, a copolymer of butyl methacrylate-acrylic acid is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/
Examiner, Art Unit 1611
November 18, 2008*

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611